

REMARKS

1. The Examiner has cited at least three (3) references in combination, and sometimes four (4), five (5) or six (6) references in combination, against the claims. This constitutes a weak citation of references against the claims. This is particularly true when, as here, some of the references do not disclose what the Examiner says that they disclose.

2. The Examiner has cited Toniolo published pending application U.S. 2006/0154220 against all of the claims and has cited Toniolo as the primary reference against most of the claims. Thus, if applicants can establish that Toniolo does not disclose what the Examiner states that Toniolo discloses and what applicants claim, all of applicants' claims should be allowed unless the Examiner can cite more pertinent references against applicants' claims.

The Examiner cites as follows on pages 2 and 3 of the Office Action dated April 24, 2007:

"Toniolo discloses providing a dance routine with music, involving at least one dancer with the dancer's head in a substantially stationary disposition (paragraph 0011), providing a video of the dance routine, with the music, showing the dancer's body but not the dancer's head, and the movement of the dancer's body in synchronism with the music (Fig. 13 & the associated text: paragraphs 0104-0106), recording the video appearance of the at least one celebrant's head during the playing of the music to the at least one celebrant (paragraph (0106))."

Paragraph 0011 in Toniolo does not disclose that the dancer's head is in a substantially stationary disposition. This is reinforced by the fact that the dancer's head is shown only in Figure 9 of Toniolo and that nothing is attached to the dancer's head in Figure 9 of Toniolo. Furthermore, Toniolo does not disclose that the dancer's head is stationary.

Paragraphs 0104-0106 of Toniolo do not disclose that the celebrant's head is substituted for Toniolo's head on Toniolo's body. Figure 9 in Toniolo is the only Figure showing a body, the dancer's body. Furthermore, it shows only one head, the dancer's head.

Page 3 of the Office Action dated April 24, 2007 includes in italics a list of admissions by the Examiner of what Toniolo does not disclose.

3. According to the Examiner on page 3 of the Office Action dated April 24, 2007, "Korn teaches disposing the head of at least one celebrant in an opening in a foreground enclosure disposed in front of the celebrant's head (Figs 5B & 5D & the associated text)..."

This is not true. Korn indicates just the opposite in the paragraph in column 5, lines 13-33. For example, Korn states in column 5, lines 22-24:

"The image in Fig. 5B includes a background portion corresponding to Fig. 5A and a foreground portion (the person sitting at the desk)." (underlining supplied)

The paragraph further states in lines 30-33:

"Fig. 5D represents the newly generated image having the same foreground portion as the current image, but the home/office background has been replaced with the background of Fig. 5C having mountains and the sun."

There are additional admissions by the Examiner on page 4 of the Office Action relating to what the combination of Toniolo and Korn does not disclose.

4. Claim 5 is dependent from allowable claim 1 and is accordingly allowable over the combination of Toniolo, Korn and Parulski for the same reasons as claim 1. Claim 5 additionally recites the step of "digitizing the recorded video of the dance routine to a computer to adjust for lateral changes in the position of the dancer's body, thereby to align the dancer's body laterally with the celebrant's head."

According to the Examiner on page 5 of the Office Action, "However, Horigami et al. teaches digitizing the recorded video of the dance routine to a computer to adjust for changes in the position of the dancer's body, thereby to align the dancer's body with the celebrant's head (column 11, lines 26-65)." Contrary to the position of the Examiner, Horigami does not disclose a digital computer in column 11, lines 26-65. Horigami also does not disclose

in column 11, lines 26-65, that adjustments are provided for lateral changes in the positions of the dancer's body, thereby to align the dancer's body laterally with the celebrant's head.

The Examiner has indicated on page 6 of the Office Action dated April 24, 2007 that Stamper et al. (hereinafter Stamper) discloses the step of "enlarging the celebrant's head to maintain an appearance of the celebrant's head on the dancer's body even with shifting the position of the dancer's body relative to the celebrant's head during the dance routine of the dancer (column 2 lines 57-60)". The sentence starting in column 2, line 57 of Stamper, reads as follows:

"The video editor enables the individual to display the transferred image; manipulate the image, e.g., crop, rotate, enlarge, reduce and adjust the contrast of the image; map the image onto animated game player, such as a three-dimensional head of such a player; change certain features of image painted on the player, such as changing the hair/eye color; and save the player with the mapped 2D image."

As will be seen, Stamper does not disclose the step recited in claim 7 of enlarging the celebrant's head laterally to maintain an appearance of the celebrant's head on the dancer's body even with a lateral shifting of the position of the dancer's body in relation to the celebrant's head during the dance routine of the dancer. This is recited in claim 8.

5. Applicants limit the movement of the celebrant's head in a lateral direction. Rosedale limits the movements of the participant's head in all directions. This may be especially seen in Figure 4A and Figure 4B of Rosedale.

6. Claims 1-23 are allowable for the following reasons, in addition to the reasons discussed above, over the combination of references cited by the Examiner.

Claim 1

Toniolo and Korn do not disclose what has been attributed to them in paragraph 3 of the Office Action. Applicants have discussed the above in detail in Section 3.

Claim 2

Claim 2 is dependent from allowable claim 2.

Claim 3

Claim 3 is dependent from claim 1 and is accordingly allowable over the combination of references for the same reasons as claim 1. Claim 3 is additionally allowable over Rosedale because it recites the step of physically restraining the positioning of at least one dancer's head only in a lateral direction so that at least one dancer's head remains substantially in a fixed position only laterally during the video showing the performance of the dance routine by the dancer.

Claim 4

Since claim 4 is dependent from claim 1, it is allowable over the combination of references for the same reasons as claim 1.

Claim 5

Because of its dependency from claim 1, claim 5 is allowable over the combination of references for the same reasons as claim 1.

Claim 6

Claim 6 is allowable over Stamper for the reasons discussed above with respect to Stamper. Claim 6 is allowable over Toniolo and Korn for the same reasons as claim 1.

Claim 7

Claim 7 is allowable over the combination of references for the same reasons as discussed above with respect to claims 1, 4, 5 and 6.

Claim 8

None of the cited references discloses the step of substituting the head of the celebrant in the recording at the place of the removed head of the dancer with the head of the celebrant in the substantially stationary lateral position.

Claim 9

There is no disclosure in any of the references of enlarging the head of the celebrant laterally relative to the head of the dancer to compensate for changes in the lateral position of the

celebrant's head while maintaining the celebrant's head on the dancer's neck. Claim 9 is also allowable over the combination of references because it is dependent from allowable claim 8.

Claim 10

None of the references discloses the step of disposing the celebrant's head in an opening in a foreground enclosure in front of the celebrant to provide for only the celebrant's head to be visible. Claim 10 is also allowable over the references because it is dependent from allowable claim 8.

Claim 11

Since none of the references discloses a foreground enclosure recited in claim 10, none of the references discloses the step recited in claim 11 of chromakeying the foreground enclosure to eliminate the foreground enclosure in the recording so that only the celebrant's head is provided in the recording.

Claim 12

None of the references discloses the step of chromakeying the background in back of the celebrant to eliminate the background.

Claim 13

None of the references including Horigami discloses the step of digitizing the video of the dance routine to a computer to adjust for changes in the dancer's body relative to the celebrant's head, thereby to align the dancer's body with the celebrant's head. Claim 13 is also allowable over the references because it is dependent from allowable claim 8.

Claim 14

Claim 14 is allowable over the references for the same reason as claims 10-13.

Claim 15

None of the cited references discloses the step of processing the disposition and appearance of the celebrant's head on the dancer's body to assure that the celebrant's head is disposed on the dancer's neck.

Claim 16

Because of its dependency from claim 15, claim 16 is allowable over the references for the same reasons as claim 15. Furthermore, none of the references including Rosedale discloses the step of restraining only the dancer's head to a substantially unitary lateral position while the dancer is performing the dance routine in synchronization with the music.

Claim 17

Claim 17 is dependent from claim 15 and is accordingly allowable over the combination of the references for the same reasons as claim 15.

Claim 18

Since claim 18 is dependent from claim 15, it is allowable over the combination of the references for the same reasons as claim 15. Claim 18 is also allowable over the combination of the references including Korn because none of the references discloses the step of eliminating the foreground of the image.

Claim 19

The Examiner has cited Parulski, Toniolo and Stamper against claim 19. However, none of the references including Stamper discloses the step of enlarging the celebrant's head relative to the dancer's head in the video image to ensure that the head is disposed on the dancer's neck regardless of a displacement of the dancer's body laterally from a particular position. The Examiner has cited column 2, lines 57-60 in Stamper as prior art against claim 19. However, Stamper provides a vague and indefinite listing in column 2, lines 57-60 and does not disclose the step recited in claim 19. Furthermore, claim 19 is allowable over the combination of the references because it is dependent from claim 15.

Claim 20

Claim 20 is allowable over the combination of references for the same reasons as claim 17 because it is dependent from claim 17.

Claim 21

Since claim 21 is dependent from claim 17, it is allowable over the combination of references for the same reasons as claim 17. Claim 21 is also allowable over the combination of

references including Horigami because none of the references discloses the step of employing digitizing techniques to adjust for changes in the lateral position of the dancer's body, thereby to align the dancer's neck with the celebrant's head.

Claim 22

Claim 22 is allowable over the combination of references for the same reasons as claim 8.

Claim 23

Claim 23 is allowable over the combination of references for the same reasons as claim 21. Claim 23 is also allowable over the combination of references for the same reasons as claim 22 because it is dependent from allowable claim 22.

7. Except for claims 8 and 13, the Examiner has cited at least three (3) references, and as many as six (6) references, against the individual ones of the claims. Even the best inventions are formed from a plurality of steps (in the instance of method claims) most of which are individually known in the prior art. However, when these method steps are combined, they produce methods which are inventive because they are not obvious to a person of ordinary skill in the art. This is true of applicants' invention. This is indicated by the fact that the Examiner has had to cite as many as six (6) references in combination against some of the claims. Furthermore, even when the references have been combined by the Examiner to reject the claims, the references in combination fail to disclose elements recited in the claims. This may be seen from the discussion above concerning the individual references and concerning the combinations of references. This shows that applicants' claims are allowable over the combination of references cited by the Examiner. The allowability of applicants' claims is further supported by the large number of U.S. patents which recite combinations of method steps each of which is individually known in the prior art.

8. In order for different prior art references to be combined to reject a claim, the references have to disclose or suggest the combination recited in the claim. *ACS Hospitality Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed.Cir. 1984). As the Federal Circuit indicated in the *ACS* case at 732 F.2d 1577, 1579, 221 USPQ 929,933:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Under Section 103, teaching of references can be combined only if there is some suggestion or incentive to do so."

None of the references cited by the Examiner to reject the claims in this application discloses or suggests certain of the features recited in the claims. There is accordingly no suggestion or incentive to combine the references to reject applicants' claims. The references cannot accordingly be combined to reject the claims.

9. Applicants have revised the declarations and powers of attorney in accordance with the suggestion of the Examiner. Applicants have executed, and are enclosing, the revised declarations and powers of attorney.

Reconsideration and allowance of the application are respectfully requested.

The Commissioner is authorized to credit any overpayment or charge any additional fees in this matter to our Deposit Account No. 06-2425.

Dated: June 25, 2007

Respectfully submitted,

FULWIDER PATTON LLP

/ellsworth r. roston/
Ellsworth R. Roston
Reg. No. 16,310

ERR:aml;jr
Enclosure

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201
182220.1